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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,812	02/19/2002	Samuel W. Barziza	BAR-01	5928

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EXAMINER

NGUYEN, THONG Q

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/683,812

Applicant(s)

BARZIZA, SAMUEL W.

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____.

DETAILED ACTION

Oath/Declaration

1. The Oath/Declaration provides a post office address; however, it is incomplete. In particular, applicant has just provided only the information relating to the City, state and zip code of the inventor. A statement over applicant's signature providing a complete post office address is required.

Drawings

2. The drawings contain eight sheets of figures 1-10 filed by applicant were received by the Office on 2/19/2002.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: In particular, the references "80" shown in figure 1; the references "261"; "265"; and "283" as shown in figure 2; the references "201" and "325" as shown in figure 2a are not mentioned in the specification. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: In particular, the reference "80" stated on line 15 of section [0019]; the reference "261" stated on line 7 of section [0020]; the references "325" and

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"325"" " stated on lines 9 and 10 of section [0024] are not shown in at least one figure.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

6. The disclosure is objected to because it does not have the section of "Summary of the Invention". Applicant should note that the section of Background of the invention as provided in pages 1-2 is not considered as the Summary of the Invention.

Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)),

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and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or

REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a).

"Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(e) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

7. The disclosure is objected to because of the following informalities: a) Page 4, section [0019], lines 18+, the description relating to the use of the screw (80), the rail and the yoke is unclear. Applicant should note that the screw (90) is used to lack the rail into the yoke (30) (see lines 9-11 of the section). Applicant should note that the use of screw and holes (80) is used to prevent the rail from failing from the yoke (30) and to prevent the camera platform (200) from falling from the rail; b) Page 5: section [0021], line 1, "Fig. 14" should be changed to -Fig. 7-; on line 2, "Fig. 17" should be changed to -Fig. 10-; c) Page 6: sections [0023] and [0024], the use of the reference "290" is improper because it is used to refer to two different items, see line 6 of section [0023] and line 1 of section [0024]. There are still some grammatical and idiomatic errors in the specification. Applicant should carefully proofread the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a) Claim 1 is rejected under 35 USC 112, second paragraph for the following reasons: 1) the feature thereof "a mount for...groove" (line 2) is unclear. It is unclear which component, i.e., the mount or the telescope, has a non-circular groove; 2) the use of the term "may be" in the claim (line 6) make the claim indefinite because it is unclear whether the components and/or the functions appeared after such terms are positively components and/or functions of the device claimed or not; 3) the claim is functional. The claim recites that a photonic device is mounted and adjusted to align with the longitudinal optical axis of the telescope system; however, the claim fails to recite at least one means or system for perform such a function; and 4) each of the features "the longitudinal optical axis" (line 7) and "the telescope system" (line 7) lacks a proper antecedent basis.
- b) Claim 2 is indefinite because each of the features "the space" (line 2) and "the telescope lens eyepiece" (line 2) lacks a proper antecedent basis.
- c) Claim 3 is indefinite because the feature "the telescope eyepiece" (lines 3-4) lacks a proper antecedent basis

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d) Claim 4 is rejected under 35 USC 112, second paragraph for the similar reason as set forth in element a(2) above. In other words, the use of the terms “whereby” and “may be” in the claim make the claim indefinite about the formation/structure of the device claimed.

Further, the feature “the yoke” (line 5) lacks a proper antecedent basis.

e) Claim 5 is indefinite by the recitation thereof “each of the planes perpendicular to longitudinal optical axis of the telescope” (lines 3-4). What does applicant means by the mentioned feature? In other words, how many planes perpendicular to an axis in applicant’s viewpoint. Applicant should note that there is only one plane perpendicular to an axis in geometry.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1-2, as best as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Boxer (U.S. Patent No. 5,625,851).

Boxer discloses a mounting apparatus for moving a lens carrier and an image carrier relative to each other. The system as described in columns 1-3 and shown in fig. 1 comprises a mount for supporting the lens carrier (12) wherein the mount comprises a non-circular groove; a platform for supporting the image carrier (914) wherein the platform comprises a non-circular groove; and a non-circular rail (100) engaging to the non-circular grooves of the mount and the platform. It is also noted that the use of an opaque hood (916) between the lens carrier and the image carrier is provided by Boxer as can be seen in column 3. With regard to the feature "telescope" recited in the claim, it is noted that the claim fails to provide any specific feature/limitations for the telescope to make the claim distinguish from the lens disclosed by Boxer.

12. Claims 1-2, as best as understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Stratton, Jr (U.S. Patent No. 6,357,937).

Stratton, Jr. discloses a coupler for coupling a telescope to a camcorder. The system as described in columns 2-4 and shown in figs. 1-2 comprises a mount (2) having non-circular groove (12) which mount supporting a telescope (1); a non-circular rail (3) insertable to the groove (12) of the mount (2); an adjustable platform (4-6, 21-22) having non-circular groove (see element 21) wherein the

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platform is attached to the non-circular rail (3) and supports a camcorder (7) via the bolt (5). As a result, the camcorder (7) is able to move along the longitudinal optical axis of the telescope (1) via the movement of the platform and the rail with respect to the groove (12) of the mount (1). It is also noted that the use of an opaque hood (7) for connecting the camcorder and the telescope lens eyepiece (9) is disclosed as can be seen in column 4, lines 1-6.

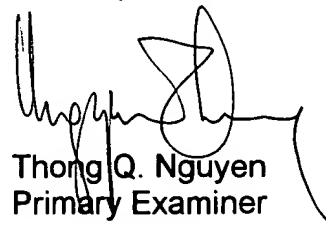
Conclusion

13. The additional references are cited as of interest in that each discloses a mounting system for mounting a camera to an optical device

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (703) 308-4814. The examiner can normally be reached on M-F.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen
Primary Examiner
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January 30, 2003